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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/870,147

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Toshiaki Tsuboi

10746/26

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26646

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11/27/2006

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EXAMINER

PASS, NATALIE

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/870,147	TSUBOI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Natalie A. Pass	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the amendment filed 6 September 2006. Claims 1, 9 and 17 have been amended.. Claims 1-17 remain pending.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Newly amended claims 1, 9, and 17 and claims 2-8, 10-16 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Independent claims 1, 9, and 17 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

- "standardized health promotion information and standardized health promotion timing" as disclosed in claims 1 , 9, and 17, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 30 May 2001. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

(B) Claims 2-8, 10-16 incorporate the features of independent claims 1, 9, and 17, through dependency, and are also rejected.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 30 May 2001.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 7, 9-11, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580 and Cairnes, U.S. Patent Number 6, 139, 494 for substantially the same reasons given in the previous Office Action (paper number 20060523).

Further reasons appear hereinbelow.

(A) Claims 1, 9, and 17 have been amended to recite

- “standardized” in lines 4-5, 8-9, and 7-8, respectively.

As per these new limitations, Strecher and Cairnes teach an apparatus, a computer readable medium, and a method as analyzed and discussed in the previous Office Action (paper number 20060523) further comprising storing standardized scenarios including health promotion information and health promotion timing (Cairnes; Figure 10, Item 458, column 2, lines 32-34, column 7, line 64 to column 8, line 1); Examiner interprets Cairnes’s teaching of “providing clinical communications and information that meet qualitative and quantitative standards” (Cairnes; column 2, lines 32-34) and “a preferred embodiment of the present invention may recommend therapies according to standards set by a particular national medical organization

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and/or institute” (Cairnes; column 7, line 64 to column 8, line 1) as teaching a form of storing standardized scenarios including health promotion information and health promotion timing.

The remainder of claims 1, 9, and 17 is rejected for the same reasons given in the prior Office Action (paper number 20060523, section 4, pages 2-7), and incorporated herein.

The motivations for combining the respective teachings of Strecher and Cairnes are as given in the rejection of claim 17 in the prior Office Action (paper number 20060523) and incorporated herein.

(B) Claims 2-3, 7, 10-11, and 15 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20060523, section 4, pages 2-7), and incorporated herein.

7. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580, and Cairnes, U.S. Patent Number 6, 139, 494, and Rieger et al. article: “Development of an Instrument To Assess Readiness to Recover in Anorexia Nervosa.” 2000. URL: <<http://www3.interscience.wiley.com/cgi-bin/fulltext/74000261/PDFSTART>>, hereinafter known as Rieger, as applied to claims 1 and 9 above, for substantially the same reasons given in the previous Office Action (paper number 20060523). Further reasons appear hereinbelow.

(A) Claims 4 and 12 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20060523, section 5, pages 7-8), and incorporated herein.

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8. Claims 5-6, 8, 13-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strecher, U.S. Patent Number 5, 207, 580, Cairnes, U.S. Patent Number 6, 139, 494, and Douglass et al., U.S. Patent Number 6, 039, 688, as applied to claims 1 and 9 above for substantially the same reasons given in the previous Office Action (paper number 20060523). Further reasons appear hereinbelow.

(A) Claims 5-6, 8, 13-14, 16 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 20060523, section 6, pages 9-10), and incorporated herein.

### *Response to Arguments*

9. Applicant's arguments filed 6 September 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 6 September 2006.

(A) At pages 7-11 of the 6 September 2006 response, Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Strecher, Cairnes, Rieger, and Douglass, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the

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prior Office Action (paper number 20060523), and incorporated herein. Specifically, Examiner notes that the recited features of “storing scenarios each of which is standardized and includes standardized health promotion information and standardized health promotion timing” are taught by the combination of applied references. In particular, Examiner interprets Cairnes’s teaching of “providing clinical communications and information that meet qualitative and quantitative standards” (Cairnes; column 2, lines 32-34) and “a preferred embodiment of the present invention may recommend therapies according to standards set by a particular national medical organization and/or institute” (Cairnes; column 7, line 64 to column 8, line 1) and “[a] patient 108 can access simple, concise information about disease states, therapies and treatments, wellness and prevention, symptoms, and medical drugs” as stored in Cairnes’s “Medical Library” (Cairnes; column 12, lines 13-15) and “[p]atient 108 selects and reads informative educational material so that the patient may better understand the patient's medical condition and the comprehensive therapies the patient may receive” (Cairnes; column 12, lines 35-38) as teaching a form of storing standardized scenarios including health promotion information and health promotion timing.

As per Applicant’s argument in paragraphs 2-3 on page 8 of the 6 September 2006 response, that the Cairnes reference “does not include ‘standardized’ information, but includes information for each patient,” and “does not disclose or suggest the feature of reading a scenario which is standardized ... [...] ... timing” Examiner respectfully disagrees, and notes that this has been discussed in the previous paragraph, and further notes that Cairnes’s discussions of “electronically providing patient 108 access to a medical library of educational materials ... [...] ...



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... In a preferred embodiment, the electronic medical library of the PHA [Personal Health Advisor] will include topics such as ... [...] ... "what to do in case of . . . " 458 [reads on 'scenarios'] ... [...] ... so that the patient may better understand the patient's medical condition and the comprehensive therapies the patient may receive from PHA [Personal Health Advisor] 120 or health providers 136" (Cairnes; Figure 10, Item 458, column 12, lines 13-39) additionally teach a form of storing standardized scenarios including health promotion information and health promotion timing.

In paragraph 4 on page 8 of the 6 September 2006 response Applicant argues that the Strecher reference does not teach the "preparing" of a health promotion schedule, as recited in claim 1. Examiner respectfully notes that it was the Cairnes reference, and not the Strecher reference that was used to reject this limitation.

With regard to Applicant's arguments in paragraph 5 on page 8 of the 6 September 2006 response that the applied references fail to teach standardized scenarios and health promotion information and health promotion timing, these features have been discussed earlier in this Office Action.

In response to Applicant's argument in pages 9-10 of the 6 September 2006 response that there is no suggestion to combine the references and that a *prima facie* case of obviousness has not been established, the Examiner notes that the motivations for combining the applied references can be found either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976).

Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 20060523). Note, for example, the motivations explicitly stated at lines 12-16 of page 5 of the previous Office Action (i.e., " ... with the motivation of providing a system that "enables care to be vastly improved by ... through clinical case management and therapy integration") (Cairnes; column 1, lines 56-64) and at the last paragraph of page 8 of the previous Office Action (i.e., " ... with the motivation of increasing the effectiveness of interventions ...") (Rieger; page 395, paragraph 4, page 388, paragraph 4) and at the first paragraph of page 10 of the previous Office Action (i.e., " ... with the motivation of providing a therapeutic program that ...") (Douglass; column 1, line 61 to column 2, line 2).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make

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modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves.

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that the Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al* 192 USPQ 278 (CCPA) that:

- (i) obvious does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In *In re Conrad* 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

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In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

As such, it is respectfully submitted that Applicant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Consequently, it is respectfully submitted that contrary to Applicant's allegations, the features that Applicant disputes are clearly within the teachings of the applied references and that Applicant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

In response to Applicant's argument at paragraph 3 on page 9 of the 6 September 2006 response, that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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With regard to Applicant's argument on pages 10-12 of the 6 September 2006 response that the applied prior art fails to disclose the argued limitations in the remaining claims, these issues have been discussed earlier in this action.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks  
Washington D.C. 20231

**or faxed to:** (571) 273-8300.

For formal communications, please mark  
"EXPEDITED PROCEDURE".

For informal or draft communications, please label  
"PROPOSED" or "DRAFT" on the front page of the  
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

November 21, 2006



JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER